

Appl. No. 09/450,023
Reply to Office Action of January 10, 2008
Amdt. Dated March 11, 2008

REMARKS

In regard to the Examiner's provisional double patenting rejection, Applicant states that an appropriate terminal disclaimer will be submitted for any allowed related application. Applicant notes that the submission of a terminal disclaimer at this point would be premature, as one or more of the applications may be abandoned in favor of either this application or another co-pending application. Accordingly, Applicant invites the Examiner to contact the undersigned attorney directly upon the allowance of any of the related applications so that an appropriate terminal disclaimer may be promptly submitted.

Applicant respectfully requests reconsideration of the claim rejections set forth by the Examiner under 35 U.S.C. § 112. Applicant respectfully submits that all of the claims in the instant application fully comport with all the requirements of title 35, section 112.

Furthermore, Applicant notes that the written description and drawings of the instant application provide more than ample support for the subject matter now claimed which clearly enables a person of ordinary skill in the art to make and use the claimed invention without undue experimentation.

As noted in the Manual of Patent Examination Procedure any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S.

Appl. No. 09/450,023
Reply to Office Action of January 10, 2008
Amendt. Dated March 11, 2008

261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one which is to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Accordingly, even though the statute does not use the term "undue experimentation," the statutory provision has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.").

Any part of the specification can support an enabling disclosure, even a background section that discusses, or even disparages, the subject matter disclosed therein. *Callicrate v. Wadsworth Mfg., Inc.*, 427 F.3d 1361, 77 USPQ2d 1041 (Fed. Cir. 2005)(discussion of problems with a prior art feature does not mean that one of ordinary skill in the art would not know how to make and use this feature). Determining enablement is a question of law based on underlying factual findings. *In re Vaeck*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984).

Appl. No. 09/450,023
Reply to Office Action of January 10, 2008
Amdt. Dated March 11, 2008

The determination that "undue experimentation" would have been needed to make and use the claimed invention is not a single, simple factual determination. Rather, it is a conclusion reached by weighing several factual considerations. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. There are many factors to be considered when determining whether a disclosure satisfies the enablement requirement.

These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (reversing the PTO's determination that claims directed to methods for detection of hepatitis B surface antigens did

Appl. No. 09/450,023
Reply to Office Action of January 10, 2008
Amdt. Dated March 11, 2008

not satisfy the enablement requirement). In *Wands*, the court noted that there was no disagreement as to the facts, but merely a disagreement as to the interpretation of the data and the conclusion to be made from the facts. *In re Wands*, 858 F.2d at 736-40, 8 USPQ2d at 1403-07. The Court held that the specification was enabling with respect to the claims at issue and found that "there was considerable direction and guidance" in the specification; there was "a high level of skill in the art at the time the application was filed;" and "all of the methods needed to practice the invention were well known." 858 F.2d at 740, 8 USPQ2d at 1406. After considering all the factors related to the enablement issue, the court concluded that "it would not require undue experimentation to obtain antibodies needed to practice the claimed invention." *Id.*, 8 USPQ2d at 1407.

Here, as in the *Wands* matter, there is considerable direction and guidance in the specification concerning the claimed subject matter; there is a high level of skill in the art at the time the application was filed. It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The Examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of non-enablement must be based on the evidence as a whole. 858 F.2d at 737, 740, 8 USPQ2d at 1404, 1407.

In regard to the specific claim elements or limitations which the Examiner has identified in the most recent office action as lacking support, Applicant has detailed below specific examples contained within the specification which provide more than ample explanation to satisfy the requisite standard set forth above. The Examiner has made the

Appl. No. 09/450,023
Reply to Office Action of January 10, 2008
Amdt. Dated March 11, 2008

general assertion that there is no support in the specification for the buyer identifying a plurality of vendors to be included in a vendor pool and creating the vendor pool prior to analysis of job data and then performing a comparison in which the vendor pool is divided into a subset wherein only members of the subset receive a solicitation.

Additionally, the Examiner identifies numerous individual elements from the independent claims in the second full paragraph in item 6 of the Examiner's office action. These appear to be the specific elements which the Examiner asserts to lack proper support in the detailed description of the instant application. Accordingly, Applicant has set forth each limitation and a detailed explanation of where the relevant subject matter can be found in the specification.

In regard to the claim language: "each buyer using the system generating an electronic communication providing information identifying a plurality of vendors for inclusion in a pool of vendors associated with said buyer to potentially receive a job solicitation, . . ." Applicant notes that this language merely describes a buyer generated electronic communication defining a pool of vendors that are to potentially receive a job solicitation.

As a preliminary matter, Applicant notes that there are numerous locations throughout the specification which describe an embodiment wherein a buyer using the system provides information identifying a plurality of vendors for inclusion in a pool of vendors that are associated with the buyer to potentially receive a job solicitation. For example, the specification on page 1 begins with an overview of the system in the description of the Field

Appl. No. 09/450,023
Reply to Office Action of January 10, 2008
Amdt. Dated March 11, 2008

of the Invention portion of the specification. This portion of the written description specifically notes that, "the present invention generally relates to an apparatus and method for creating a database representing pools of vendors of customized goods and services for one or more subscribing buyers, and . . . creating and maintaining a database representing a vendor base or pool for each subscribing buyer of customized goods and services."

This portion of the specification also explains that the system is designed for "creating and maintaining a database representing a vendor base or pool for each subscribing buyer of customized goods and services, the database further representing capabilities of said vendors." Applicant respectfully submits it is readily apparent that the database containing the vendor pool information is provided for the purpose of identifying vendors to potentially receive a job solicitation.

In specific regard to the portion of the limitation requiring: "generating an electronic communication providing information identifying a plurality of vendors for inclusion in a pool of vendors . . . , Applicant notes that at the very least page 13 describes this aspect of the system which provides the generation of an "electronic communication" providing the specified information. Specifically, Applicant notes that the first full paragraph on page 13 states that a "further described embodiment of the invention implements the reception of buyer attribute data and vendor attribute data by a website accessible through the Internet."

(emphasis added)

Appl. No. 09/450,023
Reply to Office Action of January 10, 2008
Amdt. Dated March 11, 2008

As further described in this paragraph, a website includes a graphical user interface through which potential vendors are asked to input information characterizing their products and services, their manufacturing capability, and other attribute data. Similarly, the website has a graphical user interface accessible to buyers for entering solicitation data and other information, including preferred vendors and standard or optional vendor selection criteria.

(emphasis added)

It is this so called vendor selection criteria which in the described embodiment set forth in part on page 13 is entered by a buyer using the system via the Internet that is used in defining a specific buyer's vendor pool. According to this embodiment, a buyer's vendor pool is defined by the inclusion of any preferred vendors and the use of standard and or optional vendor selection criteria for defining the buyer's vendor pool. At the very least, these portions of the specification alone more than adequately describe the claim language: "each buyer using the system generating an electronic communication providing information identifying a plurality of vendors for inclusion in a pool of vendors associated with said buyer to potentially receive a job solicitation," More specifically, the use of the Internet for the input of the specified data is clearly done via an electronic communication. It is this information which is used in defining a buyer's vendor pool that is maintained for the purpose of defining which vendors are to potentially receive a proposal or solicitation.

Furthermore, additional portions of the specification provide alternate support for this portion of the claim language. For example, the second to last paragraph on page 13 also

Appl. No. 09/450,023
Reply to Office Action of January 10, 2008
Amdt. Dated March 11, 2008

states that a "further embodiment of the invention includes means and method steps for maintaining multiple vendor pools for each of a plurality of buyers, the multiple vendor pools for a particular buyer corresponding to multiple product or service types that the buyer procures." (emphasis added) Page 16 in its final full paragraph indicates that a first example embodiment is described with reference to Figures 1 A and 1B. In this embodiment, a system database 2 is connected to the Internet via a website 4. In a preferred embodiment, the buyers and vendors each access the website 4 through respective Internet browsers. The final sentence on page 17 indicates that the potential bidders or product/service vendors are connected to the common communication network.

In light of the foregoing, it should be abundantly clear that a person of ordinary skill in the art, when reading the specification will readily understand that electronic communications for creating and/or modifying the database are utilized and that the database maintains one or more vendor pools in association with a single buyer.

Yet additional support can be found on page 28, with regard to a specific example relating to the selection of a printing vendor via the system. As noted in the beginning of the second paragraph, for this description it is assumed that the vendor attributes described in reference to Figures 1A and 1B had already been entered into the database 2 from each of the plurality of print vendors, "at the direction and with the consent of the print buyer 6." (emphasis added)

Appl. No. 09/450,023
Reply to Office Action of January 10, 2008
Amdt. Dated March 11, 2008

There should be no question that it is the buyer who defines the one or more vendor pool's which are associated with the buyer. This obviously occurs before transmission and/or analysis of a buyer invitation for bid data which clearly occurs after the vendor pools are created. This is confirmed by the fact that a buyer may have a plurality of associated vendor pools as described in the specification and as noted above depending upon the product or services to be purchased by the buyer. These are certainly defined in advance and are essentially ready and available for use at the convenience of the buyer. Accordingly, in light of the foregoing, Applicant respectfully submits that there is more than ample disclosure regarding the designated limitation and that the Examiners rejection for lack of support as to this point should be withdrawn.

In regard to the claim language: "where the system stores electronic data sufficient to identify every vendor pool and its association with a corresponding buyer based upon the buyer transmitted vendor pool identification information which occurs prior to analysis of job data pertaining to a job for which bids are sought by or on behalf of the buyer." Applicant notes that this language merely describes an electronic database defining each pool of vendors that are to potentially receive a job solicitation.

Applicant respectfully relies upon the same information noted above which clearly indicates that the vendor pools are preferably created in advance so that the buyer may have one or more vendor pools which are available for selection depending upon the product or service for which the buyer seeks a bid at any given time. For example, as noted above, the second to last paragraph on page 13 also states that a "further embodiment of the invention

Appl. No. 09/450,023
Reply to Office Action of January 10, 2008
Amdt. Dated March 11, 2008

includes means and method steps for maintaining multiple vendor pools for each of a plurality of buyers, the multiple vendor pools for a particular buyer corresponding to multiple product or service types that the buyer procures." (emphasis added)

A person of ordinary skill in the art would clearly understand that these are to be created in advance using the techniques described in the specification for the creation of the buyer's vendor pool. Accordingly, Applicant respectfully submits that there is more than ample support for this limitation in the specification as originally submitted. Accordingly, Applicant's request of the Examiner to withdraw the rejection on this basis.

In regard to the claim language: "automatically identifying via a computer processor at least one subset from the buyers associated pool of vendors as qualified for receiving the solicitation, based on said comparison" Applicant notes that this language merely describes the automated comparison of the stored vendor attributes with the buyer requirements for determining the selected or qualified vendors that are to receive a job solicitation based on the comparison. Applicant notes that various portions of the specification describe this subject matter. One example of the specific comparison identified by the Examiner is described in the first full paragraph on page 21.

This portion of the specification notes that Figure 1 A, block 14 illustrates the step of retrieving all of the vendor attributes sets from the database and comparing each to the job attributes derived from the invitation-for-bid data based on the standard selection criteria previously entered by the buyer as part of the job attributes. The comparison determines

Appl. No. 09/450,023
Reply to Office Action of January 10, 2008
Amdt. Dated March 11, 2008

which of the vendors are qualified to provide the requested customized goods or services. The comparison at block 14 also utilizes any optional selection criteria which the buyer had entered as part of the job attributes. The specific examples describes the use of geographical location information of the vendor and whether the vendor is required to be a union shop or a small disadvantaged business and the like.

Applicant further notes that illustration of Figure 1 clearly indicates to those of ordinary skill in the art that one or more computers are to be relied upon for making the specified comparison. It should be abundantly clear that the skilled artisan would not even remotely contemplate that electronic database as described would be manually reviewed for such a comparison. Accordingly, Applicant respectfully submits that each of the specific elements or limitations identified by the Examiner as lacking support are clearly described in the specification in such a manner as to undeniably provide a person of ordinary skill in the art with the requisite ability to make and use the claimed subject matter.

A conclusion of lack of enablement means that, based on the evidence regarding each of the above factors, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and/or use the full scope of the claimed invention without undue experimentation. *In re Wright*, 999 F.2d 1557,1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Here, such a conclusion is inappropriate as a fair reading of even the limited portions of the specification noted above clearly described each element as noted

Appl. No. 09/450,023
Reply to Office Action of January 10, 2008
Amdt. Dated March 11, 2008

As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 USC section 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970).

In light of the foregoing, Applicant respectfully requests that the Examiner withdraw the rejections for lack of support under 35 U.S.C. § 112. As there are no remaining rejections and the prior art has been carefully analyzed in detail over many years now Applicant respectfully request prompt reconsideration of these most recent rejections. The undersigned invites the Examiner to contact him directly should you wish to discuss any of the issues raised in the Examiner's action and/or this response.

Respectfully submitted,

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